

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte THOMAS E. SAULPAUGH, GREGORY L. SLAUGHTER,
MOHAMED M. ABDELAZIZ and BERNARD A. TRAVERSAT

NOV 14 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/653,610

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences (BPAI) on August 10, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

- (1) Appellants filed an Information Disclosure Statement (IDS) on March 31, 2005. The 1449 (in the image file wrapper (IFW) of the electronic file) associated with the IDS has not been properly signed, dated and the references have not been checked or otherwise noted. Therefore, it is not clear from the record whether the examiner considered the statement or not and whether the examiner notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

- (2) Also, there is an IDS dated 10-09-03 in the IFW that indicates that there is a PTO Form 1449 attached, however we fail to find the corresponding 1449.
- (3) Appellant appropriately filed an Appeal Brief on January 14, 2005, under 37 CFR § 41.37. The examiner mailed an Examiner's Answer on March 30, 2005, that was drafted under 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37.

The examiner is directed to the Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005) which states in part:

Briefs must comply with 37 CFR [§] 41.37, and all examiner's answers filed in response to such must comply with the guidelines set forth below.

(A) **CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER.** The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(1) *Real Party in Interest.* A statement acknowledging that the brief has identified by name the real party in interest.

(2) *Related, appeals and Interferences.* A statement identifying by application, patent appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph should be included in the Related proceedings appendix section.

(3) *Status of Claims.* A statement of whether the examiner agrees or disagrees with the statement of the status of claims contained in the brief . If the examiner disagrees with the statement of the status of the claims contained in the brief, the examiner must set forth a correct statement of the status of all the claims in the proceeding.

(4) *Status of Amendments After Final*. A statement of whether the examiner agrees or disagrees with the statement of the status of amendments contained in the brief and an explanation of any disagreement.

(5) *Summary of Claimed Subject Matter*. A statement of whether the examiner agrees or disagrees with the summary of claimed subject matter contained in the brief and an explanation of any disagreement

(6) *Grounds of Rejection to be Reviewed* on appeal. A statement of whether the examiner agrees or disagrees with the statement of the grounds of rejection to be reviewed set forth in the brief and an explanation of any disagreement.

(7) *Claims Appendix*. A Statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

(8) *Evidence Relied Upon*. A listing of the evidence relied on(e-g., patents, publications, admitted prior art); and, in the case of nonpatent references, the relevant page or pages.

(9) *Grounds of Rejection*. For each ground of rejection maintained by the examiner and each new ground of rejection (if any), an explanation of the ground of rejection.

(10) *Response to Argument*. A statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief.

(11) *Related Proceedings Appendix*. Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the "Related Appeals and Interferences" section of the answer.

Accordingly, it is

ORDERED that the application is returned to the examiner

(a) for proper consideration of the IDS filed on March 31, 2005,

notification to appellant in writing of such consideration,

- (b) to locate and have scanned into the electronic file, a copy of the 1449 of the IDS dated 10-09-03 or in the alternative, inform the BPAI where the form is located in the IFW, and
- (c) to vacate the Examiner's Answer mailed March 30, 2005, and issue a revised Examiner's Answer in compliance with 37 CFR § 41.37; and
- (d) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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